

DOCKET NO. J&J 1576

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Applicants: Axel Friese et al.

Serial No.: 08/427,648

468
Art Unit: 3308

Filed : April 24, 1995

Examiner: K. Reichle

For : TAMпон, ESPECIALLY FOR FEMININE HYGIENE, AND A
PROCESS AND APPARATUS FOR PRODUCING THIS

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Group 2700

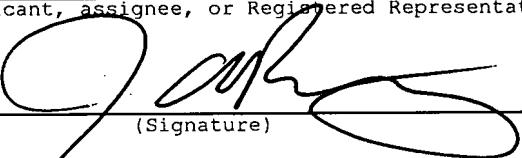
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February 16, 1999

(Date of Deposit)

Joel A. Rothfus

Name of applicant, assignee, or Registered Representative


(Signature)

February 16, 1999

(Date of Signature)

REQUEST FOR ORAL ARGUMENT
PURSUANT TO 37 C.F.R. §1.194

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Concurrent with the filing of its Reply Brief, and
pursuant to 37 C.F.R. §1.194, Appellant respectfully
requests that oral argument be heard in the above mentioned
application.

This request is being filed within two months of the Examiner's Answer which was mailed December 14, 1998 and is accompanied by the fee set forth in 37 C.F.R. §1.17(d).



Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Joel A. Rothfus Esq." The signature is fluid and cursive.

Joel A. Rothfus Esq.
Reg. No. 33,277
Attorney for Applicant(s)

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08903-7333
(732) 524-2722
Date: February 16, 1999



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**LETTER TRANSMITTING
REQUEST FOR ORAL ARGUMENT PURSUANT TO 37 C.F.R. §1.194**

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

An Examiner's Answer was mailed on December 14, 1998 in response to Appellant's Brief on Appeal filed August 10, 1998. This Reply Brief is considered timely filed as February 24, 1999 was a Sunday, and February 15, 1999 was a Federal holiday. Pursuant to Rule 1.194, three copies of Appellant's Request for Oral Argument are enclosed.

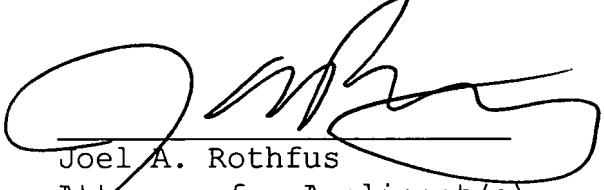
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Pursuant to 37 C.F.R. §1.17(d), the fee for filing the Request for Oral Argument, for other than a small entity, is \$260.00.



Please charge Deposit Account No. 10-0750/J&J1576/JAR in the name of Johnson & Johnson in the amount of \$260.00 for fee required by 37 C.F.R. §1.17(d), and any additional required fees to Deposit Account No. 10/0750/J&J1576/JAR. This transmittal letter is being submitted in triplicate.

Respectfully submitted,



Joel A. Rothfus
Attorney for Applicant(s)
Reg. No. 33,277

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2722
DATED: February 16, 1999

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J&J-1576

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Axel Friese et al

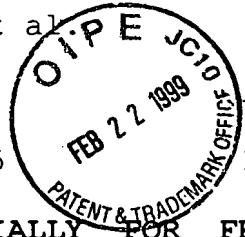
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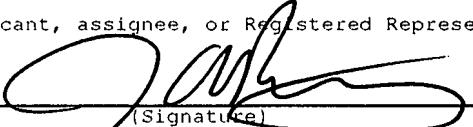
February 16, 1999

(Date)

APR 01 1999

Joel A. Rothfus

Name of applicant, assignee, or Registered Representative


(Signature)

February 16, 1999

(Date of Signature)

Group 3700

Assistant Commissioner for Patents
Washington, D.C. 20231

APPELLANT'S REPLY BRIEF PURSUANT TO 37 CFR 1.193(b)

Dear Sir:

This is in reply to the Examiner's Answer (the "Answer") mailed December 14, 1998.

I. SUMMARY OF INVENTION

Appellants disagree with the allegation in the Examiner's Answer (hereinafter the "Answer") that the Summary of Invention (Part V of the Appeal Brief) is deficient. The MPEP and CFR 1.192

require that the Summary provide a concise explanation of the invention defined in the claims involved in the appeal. Appellants have done this in their Brief. The Examiner has not disputed this. It appears that the Examiner's allegation that the Summary of Invention is deficient is based upon the dispute whether the application's complies with the requirements of 35 USC §112, first paragraph. This dispute does not render the Summary of Invention deficient, and it will be discussed in detail, below. Thus, the Summary of Invention in Appellants' Brief is sufficient for the present Appeal.

II. ISSUES

The Answer has discussed only the Issues presented in the Appeal Brief. The Answer did not discuss Issue C from the Supplemental Appeal Brief, specifically, whether the invention, as currently claimed and disclosed, is broader than that originally disclosed. The Answer merely indicated that the Advisory Action cited in the Appeal Brief relied on positions set forth in the Final Rejection. Therefore, Appellants must conclude that it is no longer the Office's position that the invention, as currently claimed and disclosed, is broader in scope than that originally disclosed. Appellants will address only Issues A and B from the Appeal Brief, i.e., whether claims 9-12, 14-19, and 23-26 are properly rejected under 35 USC §112, First Paragraph, Possession Of The Claimed Invention (Issue A), and 35 USC §112, First Paragraph, Enablement (Issue B).

III. ARGUMENTS

A. REJECTION OF CLAIMS 9-12, 14-19, AND 23-26 UNDER 35 USC §112, FIRST PARAGRAPH (POSSESSION OF THE CLAIMED INVENTION)

The test for possession of a claimed invention, is stated in the MPEP (2163.02). It has adopted Vas-Cath, Inc., v. Mahurkar, 935 F.2d 1555, 1563-64, for the rule that an applicant must convey with reasonable clarity to those skilled in the art that, at the time of filing, he was in possession of the invention as claimed. If the claims are amended at a time later than the filing date, the possession of the later claimed invention must also be reflected in the original disclosure.

1. Apparatus Claims (Claims 9-12 and 14-19)

As more fully discussed in Appellants' Summary of Invention relating to the Apparatus Claims in their Brief, specific portions of the specification were shown to fully support all relevant elements of Independent Claim 9. The Answer did not dispute this. Therefore, the present rejection of Claim 9 (possession of the invention) must fall. In addition, there has been no indication that the claims dependent from Claim 9 have any specific failings under 35 USC §112, First Paragraph, and the present rejection of these claims must also fall.

The Patent Office nonetheless maintains that the specification fails to reasonably convey to one skilled in the art that the inventors had possession of the invention claimed in the Apparatus Claims, when filed. This position is allegedly supported in the Final Office Action at page 2, last line, through page 3, line 2:

See new matter objection to the specification *supra* and MPEP 2163.06, i.e. claim limitations, e.g. the

interpretation thereof in light of the specification, e.g. what is the "tampon" as referred to claims 9-12, 14-9 and the species encompasses by claims 23-26 and 28, are affected by added material.

As described more fully below in the Product Claims portion of this Issue, the new matter objection is not relevant to the Apparatus Claims. The only claim limitation that appears to trouble the Office is that the interpretation of the word "tampon" is somehow called into question.

Words in a claim will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently. Casler v. United States, 15 Cl. Ct. 717, 9 USPQ 2d 1753 (1988). There is no evidence that Appellants in the present specification have attempted to define the term "tampon" in any way other than its ordinary and accustomed way. Therefore, this term is given its ordinary and accustomed meaning. Using this meaning in the context of the Apparatus Claims, there can be no question but that one of ordinary skill in the art would recognize that Appellants were in possession of the invention claimed in the Apparatus Claims when the application was originally filed. Thus, the position of the Office regarding the Apparatus Claims is unsupported, and the present rejection of the Apparatus Claims must be reversed.

2. Product Claims (Claims 23-26)

As more fully discussed in Appellants' Summary of Invention relating to the Apparatus Claims in their Brief, specific portions of the specification were shown to fully support all relevant elements of Independent Claim 23. While the Answer has disputed this, the Office's position is not supported by the facts.

The Patent Office nonetheless maintains that the specification fails to reasonably convey to one skilled in the

art that the inventors had possession of the invention claimed in the Product Claims, when filed. Again, This position is allegedly supported in the Final Office Action at page 2, last line, through page 3, line 2:

See new matter objection to the specification supra and MPEP 2163.06, i.e. claim limitations, e.g. the interpretation thereof in light of the specification, e.g. what is the "tampon" as referred to claims 9-12, 14-9 and the species encompasses by claims 23-26 and 28, are affected by added material.

The "new matter objection" referenced in this passage relates to amendments made to the specification at page 3, lines 20-21. In order to clarify this, a copy of the amended specification at page 3, lines 9-21, is attached as Exhibit A. This amended specification reflects the amendments filed on or about January 28, 1993, and August 19, 1994. Thus, the Office has made the new matter objection a significant part of the §112, first paragraph, rejection.

Although there have been amendments to the passage describing Fig. 2, there have been no objections to these amendments. Therefore, Appellants must conclude that this language is acceptable to the Office.

The allegations of new matter remaining in the present application relate to the amendments to the description of Fig. 4. However, these amendments are fully consistent with the description of this figure later in the specification, specifically at page 7, lines 26-29, where adjacent ribs touch "one another at their outer ends". It is clear that the current description of Fig. 4 at page 3, lines 20-21, does not contain impermissible new matter.

Secondly, the Office has questioned what "species" of tampons is encompassed in Claims 23-26.

It should be noted that the Office has never required any Election of Species during the prosecution of the present application. As discussed above, the term "tampon" is well

understood by one of ordinary skill in the art. Independent claim 23 relates to a genus, not to a "species" of a tampon having only open or closed grooves. This claim encompasses any and all disclosed embodiments.

The original specification, at page 4, lines 12-27, describes an exemplary embodiment of the tampon (illustrated in Figs. 2 and 3) as it is formed. First, the preform is formed having a compressed core and outwardly extending ribs that are separated "by outwardly open longitudinal grooves". Then, the ribs are distorted by exposure "to a low uniform radial pressure . . . [to] form a soft essentially smoothly cylindrical surface" of the final tampon product. Thus, the originally open grooves are substantially closed to form an essentially, although not necessarily completely, smoothly cylindrical surface. One of ordinary skill in the art would understand that the resulting tampon has grooves that separate adjacent ribs at their proximal end where they emerge from the core. One would also understand that the distal ends of the ribs are moved towards adjacent ribs to essentially enclose the grooves at the distal ends of the ribs and that the proximal ends of the ribs are separated by an amount greater than proximate the distal ends. Referring now to Claim 23 in the Appendix to the Appeal Brief, one of ordinary skill in the art, having read the foregoing cited passage from the specification and considered the illustration in Fig. 2, would clearly understand that the inventors possessed and described the tampon as claimed in Claim 23.

In support of this position, Appellants filed, on or about August 19, 1994, a Declaration under 37 CFR 1.132 by Engqvist that showed that the nature of the tampon material may result in products with open grooves, closed grooves, or some combination of both open and closed grooves. In contrast, the Patent Office has supplied no evidence or support, other than bald assertion, for the position that one of ordinary skill in the art would not have recognized Appellants' possession of their invention as of

the filing date. In view of the foregoing, one of ordinary skill in the art would surely recognize that there may be some variability in the fibrous tampons and their ribs and that this is consistent with the original disclosure.

Moreover, Fig. 4 and its associated discussion at page 7, lines 26-29, clearly describes a tampon having grooves wherein adjacent their distal ends, the ribs touch.

Based upon the above, the position of the Office regarding the Product Claims is also untenable. Therefore, the present rejection of the Product Claims must be reversed.

B. REJECTION OF CLAIMS 9-12, 14-19, AND 23-26 UNDER 35 USC §112, FIRST PARAGRAPH (ENABLEMENT)

Although this issue employs different language than Issue A, above, it has the same genesis. The Office alleges that Figs. 2 and 4 are inconsistent - Fig. 2 shows outwardly open grooves and Fig. 4 shows outwardly closed grooves. Paper No. 28 (referred to in this objection) concludes that the specification fails to adequately teach how to make/use the invention, because it is allegedly unclear whether the tampon, as made, includes open or closed grooves.

The MPEP (2164.01) has pointed to Mineral Separation v. Hyde, 242 US 261, 270 (1916), as setting the standard test of enablement: is the experimentation needed to practice the invention undue or reasonable.

1. Apparatus Claims (Claims 9-12 and 14-19)

With respect to the Apparatus Claims, the claims relate to an apparatus for forming a tampon, not the tampon itself. There is no alleged confusion about any of the Figures or description in the Final Rejection or the Answer. There is no alleged need for

experimentation. Therefore, the specification and drawings, as a whole, enable the Apparatus Claims.

Moreover, the Answer has pointed only to its arguments regarding Issue A for this rejection. However, these arguments do not provide any evidence that any experimentation is necessary to practice the invention or even to determine whether one is practicing the invention. For this reason alone, the Office has failed to make a case of non-enablement of the Apparatus Claims, and the present rejection of these claims must be reversed.

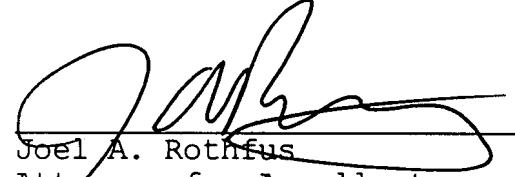
2. Product Claims (Claims 23-26)

Independent Product Claim 23 is reprinted in Exhibit A to the Appeal Brief. It does not require the expediency of open or closed grooves. It is respectfully submitted that the issue of whether the grooves are open or closed is not, *per se*, critical to the invention, provided of course, that the limitations of Claim 23 are met. As clearly stated in this claim, "each of the ribs is separated from adjacent ribs at the proximal end by an amount greater than such rib is separated from an adjacent longitudinal rib proximate the distal end" (Claim 23). This relationship is disclosed in both Figs. 2 and 4. Therefore, this claim is enabled. Further, Claim 25 requires that "each of the longitudinal ribs contacts an adjacent longitudinal rib at a point adjacent its distal end". This is specifically enabled at page 7, lines 24-29. Thus, assuming arguendo that Claim 23 is not enabled; Claim 25 certainly is.

Again, the Answer fails to provide any evidence that any experimentation is necessary to practice the invention. In addition, it contemplates that at least Claim 25 is enabled, stating at page 5, second paragraph, "at most the entire invention is not enabled, at the very least all embodiments thereof are not enabled."

It is clear that the Product Claims are enabled, and the present rejection of these claims must be reversed.

Respectfully submitted,



Joel A. Rothfus
Attorney for Appellants
Reg. No. 33,277

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February 16, 1999

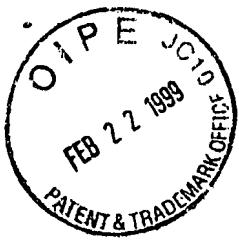


Exhibit A

Excerpt of Page 3, Lines 9-21 of the
Specification, As Currently Pending

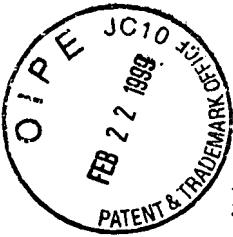
The invention is explained in more detail below by means of the diagrammatic drawing of an exemplary embodiment of a tampon and of an apparatus for producing this. In the drawing:

Fig. 1 shows the tampon according to the invention in a middle longitudinal section along the sectional line I - I in Fig. 2,

Fig. 2 shows a cross-section along sectional line II - II shown in Fig. 1, showing the tampon of the current invention having outwardly open grooves,

Fig. 3 shows a cross-section through the preform along the line III - III in Fig. 10,

Fig. 4 shows a cross-section of the tampon of the invention having closed grooves,



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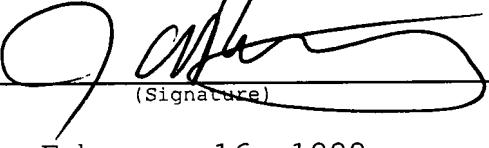
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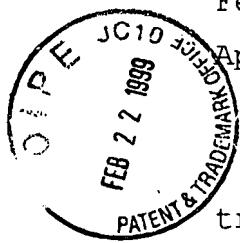
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If a fee is required, this transmittal is submitted in triplicate and the Commissioner is authorized to charge Deposit Account No. 10-0750/J&J1576/JAR.

A Request for Oral Argument pursuant to 37 C.F.R. §1.194, including the fees required under 37 C.F.R. §1.17(d), is being filed under separate cover concurrently herewith.

Respectfully Submitted,

Joel A. Rothfus, Esq.
Reg. No. 33,277
Attorney for Applicant(s)

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